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Applicant: Skiadopoulos *et al.*

Application No.: 10/667,141

Filed: September 18, 2002

Title: RECOVERY OF RECOMBINANT HUMAN
PARAINFLUENZA VIRUS TYPE 2 (HPIV2) FROM
CDNA AND USE OF RECOMBINANT HPIV2 IN
IMMUNOGENIC COMPOSITIONS AND AS VECTORS
TO ELICIT IMMUNE RESPONSES AGAINST PIV AND
OTHER HUMAN PATHOGENS

OFFICE OF PETITIONS

: DECISION

: DISMISSING

: PETITION

This is a decision on the "PETITION UNDER 37 CFR 1.183 TO WAIVE RULE TO PERMIT FILING OF REFERENCES ON COMPACT DISK," filed March 21, 2007 ("the petition"). The petition requests waiver of 37 CFR 1.98(a)(2) to submit, in lieu of paper copies, electronic copies on compact disk of references cited in an information disclosure statement (IDS) filed concurrently with the petition on March 21, 2007.

Petitioner paid by check the petition fee of \$400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183.

For the reasons set forth herein, the petition is dismissed.

DISCUSSION

37 CFR 1.98(a)(2) provides that any IDS filed under § 1.97 shall include:

A legible copy of:

- (i) Each foreign patent;
- (ii) Each publication or that portion which caused it to be listed, other than U.S. patents and U.S. patent application publications unless required by the Office;
- (iii) For each cited pending unpublished U.S. application, the application specification including the claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion; and
- (iv) All other information or that portion which caused it to be listed.

37 CFR 1.183 states:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

The instant petition has been fully considered. 37 CFR 1.98(a)(2) requires legible copies of certain documents listed on an IDS filed under 37 CFR 1.97 be submitted to the Office. Petitioner seeks waiver of this copy requirement for the IDS that was filed concurrently with the petition on March 21, 2007. The provisions of 37 CFR 1.98(a)(2) may be waived under 37 CFR 1.183 where a petitioner demonstrates an extraordinary situation in which justice requires suspension of the rule.

In support of the petition for waiver of 37 CFR 1.98(a)(2), petitioner notes that the IDS includes a large number of documents, several of which are PCT publications of great length. Petitioner submits that:

[D]ue to the number of references submitted and the volume of paper that would be required to comply with 37 CFR 1.98(a)(2) by filing of paper copies of the references, it is in the interest of the USPTO and Applicants to accept the references on Compact Disk. In particular, acceptance of the references on Compact Disk avoids the waste of USPTO resources for scanning of the references for inclusion in the Image File Wrapper of the present application, and avoids the waste of Applicants' resources for printing of paper copies of the references in the first instance.¹

As a general rule, waiver of a rule in the interest of justice is not available when there is recourse within the rules of practice. In this instance, petitioner requests waiver of the rules governing submission of documents to the Office based on the alleged waste of Office and applicant resources if paper copies of a large number of references were submitted to the Office. In lieu of submitting paper copies of the references, however, petitioner may use the Office's web-based electronic filing system (EFS-Web) to electronically submit copies of the references to the Office with an IDS (e-IDS).² Using EFS-Web, petitioner may electronically submit copies of the references to the Office in portable document format (PDF), which will avoid wasting applicants' resources as it appears applicant already has copies of each of the references in PDF format.³

¹ Petition at page 2.

² See *Manual of Patent Examining Procedure* § 609.07 (8th ed. 2001) (Rev. 7, July 2008) (providing that "[a]s of May of 2002 IDSs may be submitted to the Office via the EFS" and that "[a]s of January 2007, an e-IDS filed via EFS-Web may include citations of U.S. patents, U.S. patent application publications, foreign patent documents and non-patent literature (NPLs)").

³ See petition at page 2, item (C) (identifying "a Compact Disk including a .pdf file for each reference").

Moreover, EFS-Web can accommodate submission of an e-IDS that contains a listing of a large number of references.⁴ Foreign references and non-patent literature are submitted as separate PDF attachments and are indexed as "Foreign Reference" and "NPL Documents" under the IDS/References category (copies of U.S. patents and patent application publications are not required to be submitted).⁵ Up to sixty files can be uploaded per submission, and the filer may submit any additional electronic files as follow-on documents later on the same day as the initial filing.⁶

Additionally, contrary to petitioner's assertion, it would not be in the Office's interest to accept petitioner's submission of the references on compact disk as the Office presently has no facility for importing such files from compact disk directly into the image file wrapper (IFW) of the instant application.⁷ Rather, the Office would be required to undergo the time-consuming and costly steps of printing out each of the references submitted on compact disk and scanning the printed references into the IFW. Nor is it in applicant's interest for the Office to accept petitioner's submission of the references on compact disk as manual scanning of the references printed from the compact disk increases the potential for error on the part of the Office and would likely reduce the quality of the copies of the references that are entered into the IFW.

Accordingly, for all of the reasons set forth above, petitioner has not presented facts that demonstrate an extraordinary situation in which justice requires suspension of 37 CFR 1.98(a)(2), and the petition is dismissed.

CONCLUSION

The petition is dismissed for the reasons set forth herein, and the application is being forwarded to Technology Center 1600 for further processing. Telephone inquiries regarding this communication should be directed to Nicole Dretar at (571) 272-7717.



Brian Hanlon
Deputy Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

⁴ See *Manual of Patent Examining Procedure* § 609.07 (8th ed. 2001) (Rev. 7, July 2008) (providing that an individual e-IDS may contain a listing of (1) a combined total of 50 U.S. patents and U.S. patent application publications, (2) 50 foreign patent documents, and (3) 50 NPLs, and that more than one e-IDS may be submitted if these numbers are exceeded).

⁵ See *Frequently Asked Questions about EFS-Web*, Question p220efs221, at http://www.uspto.gov/ebs/efs_faq.htm.

⁶ See *Legal Framework for EFS-Web* § XVI (September 2008) at <http://www.uspto.gov/ebs/portal/efs/legal.htm>.

⁷ See *Frequently Asked Questions about EFS-Web*, Question p242efs586, at http://www.uspto.gov/ebs/efs_faq.htm.